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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,605	05/09/2001	William Wine	4754-41	2576
23416	7590	10/06/2005	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP P O BOX 2207 WILMINGTON, DE 19899			LAYE, JADE O	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/851,605

Applicant(s)

WINE ET AL.

Examiner

Jade O. Laye

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☒ Claim(s) 5 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/9/02 5129102</u>  | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

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### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on 5/29/02 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement has been considered by the examiner.

### *Claim Objections*

2. Claims 5 and 10 are objected to because of the following informalities: Each contains the phrase, "...the location..." which lacks antecedent basis.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-8, and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by *Shoff et al.* (US Pat. Pub. No. 2004/0210824).

As to Claim 1, *Shoff et al* disclose an interactive entertainment system which also supplies supplemental data (i.e., data related to programming). The invention also provides a method of controlling the display of said supplemental data, comprising selecting thematically appropriate content (i.e., related content) and dynamically changing said content to ensure appropriateness to the multimedia theme being displayed. (Abstract; Par. [0002, 0010-0012, 0015-0018, & 0018]). Accordingly, *Shoff et al* anticipate each and every limitation of Claim 1.

Claims 6 and 11 correspond to Claim 1. Thus, each is analyzed and rejected as previously discussed.

As to Claim 2, *Shoff* further discloses the system synchronizes the supplemental content with multimedia frames. (Par. [0067]). Therefore, as the multimedia content changes over time (i.e., frames also change), the supplemental content will be changed to correspond with said frames. Accordingly, *Shoff et al* anticipate each and every limitation of Claim 2.

Claims 7 and 12 correspond to Claim 2. Thus, each is analyzed and rejected as previously discussed.

As to Claim 3, *Shoff* further discloses the use of a data structure (i.e., control file), which informs (i.e., triggers) the system when supplemental information is present. (Pars. [0019, 0038-0041, 0059, 0061, & 0062]). Accordingly, *Shoff et al* anticipate each and every limitation of Claim 3.

Claims 8 and 13 correspond to Claim 3. Thus, each is analyzed and rejected as previously discussed.

As to Claim 5, *Shoff* further teaches the system allows for dynamic changes of display content. (Par. [0070 & 0078]). Accordingly, *Shoff et al* anticipate each and every limitation of Claim 5.

Claim 10 corresponds to Claim 5. Thus, it is analyzed and rejected as previously discussed.

As to Claim 14, *Shoff* further discloses the system contains a database, which stores the supplemental content (which can be advertising or i.e., commercial info). (Par. [0036]). In addition, the system is capable of locating triggers via frame analysis. (Par. [0067]). The remainder of Claim 14's recited limitations are encompassed within the limitations of Claims 1-3. Accordingly, *Shoff et al* anticipate each and every limitation of Claim 14.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 4, 9, 15-20, 22-25, 27-30, 32-35, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Shoff et al* in view of *Andrade et al.* (US Pat. Pub. No. 2002/0059644).

Claim 4 recites the method of Claim 3, wherein the triggers are VBI tokens having timestamps corresponding to points along the multimedia stream at which the content thereof changes. As discussed above, *Shoff et al* anticipate each and every limitation of Claim 3, and *Shoff* further discloses the use of triggers which enable the system to detect supplemental content within each multimedia frame. (Par. [0067]). But, *Shoff* fails to specifically disclose whether said triggers are located within the VBI. However, within the same field of endeavor, *Andrade* disclose such a teaching. (Par. [0038]). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Shoff* and *Andrade* in order to provide a more bandwidth efficient method of transmission.

Claim 9 corresponds to Claim 4. Thus, it is analyzed and rejected as previously discussed.

The limitations of Claim 15 are encompassed within the limitations of Claim 4. Thus, it is analyzed and rejected as discussed therein.

As to Claim 16, *Shoff* further teaches the system stores the multimedia and control file information in a database and will subsequently retrieve said data at the request of the user (for example, when the user changes a channel). (Pars. [0017, 0034-0036, & 0047]). Accordingly, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim 16.

As to Claim 17, *Shoff* further discloses the system can be used in conjunction with a web browser. (Par. [0017]). The remainder of the limitations are inherent in view of the Claims 1-5 because Claim 17 is directed to a method of producing the stream recited in Claims 1-5. Accordingly, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim 17.

Claims 22 and 27 are encompassed within the limitations of Claim 17 (and Claims 1-5). Thus, each is analyzed and rejected as previously discussed.

As to Claim 18, *Shoff* further teaches the supplemental content can be advertisements. (Par. [0018]). Accordingly, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim 18.

Claims 23 and 28 correspond to Claim 18. Thus, each is analyzed and rejected as previously discussed.

Claim 19 is encompassed within Claim 1. Thus, it is analyzed and rejected as discussed therein.

Claims 24 and 29 correspond to Claim 19. Thus, each is analyzed and rejected as discussed therein.

As to Claim 20, *Shoff* further discloses the advertisements are stored in a database, but fails to specifically disclose whether this database is maintained by advertisers. (Par. [0036]). However, this limitations would be encompassed by and/or an obvious variant of *Shoff*'s "database." Accordingly, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim 20.

Claim 25 corresponds to Claim 20. Thus, it is analyzed and rejected as previously discussed.

The limitations of Claim 30 are encompassed within Claims 4 and 20. Thus, it is analyzed and rejected as discussed therein.

The limitations of Claim 30 are encompassed within Claims 1-4. Accordingly, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim 30.

Claims 33, 34, and 35 correspond to Claims 18, 19, and 30, respectively.

As to Claim 37, *Shoff* discloses the supplemental data can be transmitted separate from the multimedia stream. (Fig. 4) (the VBI limitation of addressed under Claim 4). Accordingly, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim 37.

5. Claims 21, 26, 31, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Shoff et al* in view of *Andrade et al* as applied to claim 18 above, and further in view of *Kraft et al*. (US Pat. No. 6,516,312).

Claim 21 recites the method of Claim 18, wherein the links related to the contents are located by searching at least one thesaurus database using the textual information as keywords. As discussed above, the combined systems of *Shoff* and *Andrade* disclose all limitations of Claim



18, but fail to specifically disclose the limitations of Claim 21. However, within the same field of endeavor, *Kraft et al* disclose a similar system which utilizes a dictionary or thesaurus search engine to retrieve URLs that correspond to keywords entered by a user. (Abstract; Col. 6, Ln. 9-33; Fig. 2). Accordingly, it would have been obvious to one having ordinary skill in this art at the time of Applicant's invention to combine the systems of *Shoff*, *Andrade*, and *Kraft* in order to provide a system which supplies URL's within the context of entered keywords, thereby providing a more efficient search engine.

Claims 26, 31, and 36 correspond to Claim 21. Thus, each is analyzed and rejected as previously discussed.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. *Ullman et al* (US Pat. No. 6,018,768) disclose a system which transmits enhanced video programming.
- b. *Feinleib* (US Pat. No. 6,037,932) discloses a method of sending data within the VBI.
- c. *Watts et al* (US Pat. No. 6,324,694) disclose a method for providing supplemental data synchronously with video programming.
- d. *Slaney et al* (US Pat. Pub. No. 2002/0062481) disclose a method for selecting advertisements.

- e. *Feinleib et al* (US Pat. Pub. No. 2005/0028195) disclose a method of synchronously transmitting supplemental data with video programming.
- f. *Kaplan* (US Pat. No. 6,058,430) discloses a system which encodes URL's in the VBI.
- g. *Yagawa et al* (US Pat No. 6,857,131) disclose a system which displays an image and data related to the image based upon a user profile.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jade O. Laye whose telephone number is (571) 272-7303. The examiner can normally be reached on Mon. 7:30am-4, Tues. 7:30-2, W-Fri. 7:30-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner: Jade O. Laye  
September 29, 2005.



VIVEK SRIVASTAVA  
PRIMARY EXAMINER